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08/429,579 04/27/95 MCGOVERN

E 940497

EXAMINER

BRUNSMAN, D

A1M1/1218

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ART UNIT

PAPER NUMBER

3

1108

DATE MAILED:

12/18/95

This is a communication from the Examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This Application has been examined.

A shortened statutory period for response to this action is set to expire 3 months from the date of this letter.
Failure to respond with the period for response will cause the application to become abandoned. 35 USC 133.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

Notice of References Cited by Examiner, PTOL-892.

Notice of Art Cited by Applicant, PTOL-1449.

Part II SUMMARY OF ACTION

Claims 1-12 are pending in this application.

of the above claims _____ are withdrawn from consideration.

Claims _____ have been cancelled.

Claims _____ are allowed.

Claims 1-12 are rejected.

Claims _____ are objected to.

Claims _____ are subject to restriction or election requirement

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Claims 1-3, 9 and 10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "derivative" is indefinite in scope in that the claims do not define the extent of modification possible to yet be considered a "derivative." The term "significant" is indefinite in that it is relative to an unexpressed standard. Claims 2, 3 and 10 recite addition of materials to a composition which is restricted in the parent claims to "consisting essentially of", thus excluding addition of materials which affect the basic and novel characteristics of the invention.

Claim 8 is rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

The Markush group recited appears to include all possible amines and is therefore indistinguishable from claim 6.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear,

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concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description.

There is no basis for the addition of "coal tar", only "road tar."

Claim 2 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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Claims 1-3 and 6-12 are rejected under 35 U.S.C. § 103 as being unpatentable over McGovern (US Patents 3221615, 3261269 and 4661378) in view of Demangeon et al.

McGovern teaches the use of the bituminous materials of the instant claims, including the addition of road tar and coal tar solvent, as pavement dressing. The difference between the McGovern patents and the instant claims is its form as an oil in water emulsion containing water and an emulsifier.

Demangeon teaches emulsification of bituminous coating materials using water and 0.03 - 3.0 % cationic nitrogenous emulsifiers that fall within the scope of the instant claims, including the addition of an acid to adjust pH. The addition of acid necessary to adjust pH would appear to fall within the scope recited in the instant claims. It would have been obvious to one of ordinary skill in the art at the time of invention to form an oil in water emulsion of the materials of the McGovern patents in order to allow application at ambient temperatures. See column 7, line 1 through column 8, line 58.

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Claim 4 is rejected under 35 U.S.C. § 103 as being unpatentable over McGovern in view of Demangeon et al, as applied above, further in view of Hendrix.

The further difference between the prior art and the instant claims is the emulsifier employed. Hendrix teaches, column 3, lines 49-65, the use of alkali metal soaps as bitumen emulsifiers. It would have been obvious to one of ordinary skill in the art to employ the soap as the emulsifier because Hendrix teaches that it also functions as an emulsifier in bituminous emulsions. The addition of caustic and fatty acid is considered indistinguishable from the addition of the reaction product, soap.

Claim 5 is rejected under 35 U.S.C. § 103 as being unpatentable over McGovern in view of Demangeon et al, as applied above, further in view of Gibson et al.

The further difference between the prior art and the instant claims is the emulsifier employed. Gibson et al teach the use of 0.5 - 2 % polyvinyl alcohol as the emulsifier in bituminous emulsions. It would have been obvious to one of ordinary skill in the art at the time of invention to employ polyvinyl alcohol

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because Gibson et al teach it functions as an emulsifier for bituminous emulsions.

In determining the relevant art one looks to the nature of the problem confronting the inventor. Weather Engineering Corp. of America v. United States, 204 USPQ 41, 46-47.

Having thus determined the scope and content of the prior art and the level of skill in the said art at the time the invention was made, it is the examiner's position that the claimed invention, as a whole, would have been obvious to one of ordinary skill in the art at the time the invention was made.

The mere failure of a reference to disclose all the advantages asserted by applicant is no a substitute for actual differences in properties. In re DeBlauwe, 222 USPQ 191. An apparently old composition cannot be converted into an unobvious one simply by the discovery of a characteristic one cannot glean from the cited prior art. Titanium Metals Corp. v. Banner, 227 USPQ 773.

Accordingly, the burden of proof is upon applicant to show that the instantly claimed subject matter is different from and unobvious over that taught

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by the prior art relied upon. In re Brown, 173 USPQ 685, 689; In re Best, 195 USPQ 430; In re Marosi, 21 USPQ 289, 293.

Any evidence to be presented under 37 C.F.R. 1.131 or 1.132 should be submitted before final rejection in order to be considered timely. It is anticipated that the next office action will be a final rejection.

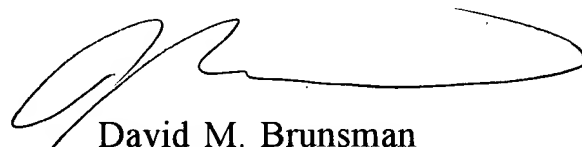
Any foreign language documents submitted by applicant have been considered to the extent the short explanation of significance, English abstract or English equivalent allow.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunzman whose telephone number is (703) 308-0662

DMBrunzman

11 December 1995



David M. Brunzman
Primary Examiner
Group 1100